

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAX A. FEDOR,
ERIC R. COLBURN,
ROBERT G. GILLIO, DANIEL W. NEU
and R. MICHAEL MCGRADY

Appeal No. 2005-1136
Application No. 09/014,076

MAILED

SEP 15 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 41.50(a)(1) and MPEP § 1211, this application is again remanded to the examiner to clarify the record with respect to the 37 CFR § 1.131 Declaration of R. Michael McGrady, the self-proclaimed "joint inventor of the subject matter described in claims 38-53" (declaration, ¶ 2). The appellants filed the declaration on August 30, 2000 (Paper No. 7) to swear back of the Pearson '232 and Meador references by establishing that the invention claimed in the instant application, or an obvious variation thereof, "was completed by being conceived and reduced to

practice in this country prior to March 7, 1994" (declaration, ¶ 6).

In the face of the examiner's apparent finding that the declaration was sufficient to show such conception and reduction to practice, an earlier merits panel of this Board found it necessary to remand the application to the examiner (see Paper No. 21) with observations that (1) the declaration was made by only one of the joint inventors of the subject matter claimed, a circumstance deemed to be troubling in light of the declarant's many references to "my" invention and activities which "I" performed and the lack of any specific mention of the contributions of the other joint inventors, and (2) the declaration was not accompanied by any evidence documenting the asserted activities leading to the alleged reduction to practice¹ or a satisfactory explanation for the absence of such evidence. Pointing out that the declaration appeared on its face to be fatally flawed for reasons specified in MPEP §§ 715.04 and 715.07, the earlier merits panel directed the

¹ As noted in the earlier remand (see page 4, n.2), the only evidence submitted with the declaration was a SelecTrac Functional Specification (Software) document proffered in conjunction with the declarant's assertion of a conception of the claimed invention (see ¶ 5a of the declaration), and which does not, and is not asserted to, constitute proof of the stated activities.

examiner to reassess the merits of the declaration and to take appropriate action consistent with the reassessment including, if the declaration was again found to be acceptable, furnishing a cogent explanation as to why the foregoing criticisms were unfounded.

The examiner's response to the earlier remand (see Paper No. 22, pages 3 through 7) attempts to explain away the inconsistencies in the declaration relating to the inventorship of the claimed subject matter and simply states with respect to the manifest evidentiary deficiencies of the declaration that "[t]he examiner has no evidence refuting applicant's 131 affidavit [sic, declaration] attesting a conception date 9 months earlier than his priority date per parent application 08/186285^[2] of the two claims 38 and 48 as established via the affidavit" (page 5). The clear contradictions in the declaration relating to inventorship, however, belie the examiner's tortured effort to explain them away,

² According to the appellants, the instant application is a division of Application 08/361,783, filed December 16, 1994, now U.S. Patent No. 5,790,409, a continuation-in-part of Application 08/186, 285, filed January 25, 1994, now U.S. Patent No. 5,533,079, and a continuation-in-part of Application 08/009,055, filed January 25, 1993, now U.S. Patent No. 5,404,384. The examiner's reference to a conception date nine months earlier than a priority date per parent application 08/186,285 is not understood.

and the fact that the examiner has no evidence refuting the statements made in declaration does not cure the lack of requisite documentation for the alleged reduction to practice or a satisfactory explanation for the absence thereof.

Hence, once again, the examiner is directed on remand to reassess the merits of the McGrady declaration and to take appropriate action consistent therewith, and to cogently and specifically explain, if the declaration is again found to be acceptable, why the evident inventorship and lack of evidence problems are unfounded.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

John P. McQuade
JOHN P. MCQUADE
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2005-1135
Application No. 09/014,076

Page 6

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